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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,532	07/24/2001	John A. Wheatley	54358USA5J.067	4765

32692 7590 11/18/2003

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EXAMINER

SHAHER, RICKY D

ART UNIT PAPER NUMBER

2872

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/911,532

Applicant(s)

WHEATLEY ET AL

Examiner

Ricky D. Shafer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-40 is/are pending in the application.
- 4a) Of the above claim(s) 31,31(32)-31(35) and 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30,30(32),30(33),30(34) and 30(35) is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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1. Applicant's arguments filed 29 August 2003 have been fully considered but they are not persuasive.

In response to applicant's general argument that there is no suggestion or motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or In The Knowledge Generally Available To One Of Ordinary Skill In The Art. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (FED. CIR. 1988) and In re Jones, 958 F.2d 347, 21 U.S.P.Q. 2d 1941 (FED. CIR. 1992). In this case, Utsumi ('953) and Utsumi ('772) each clearly teach it is known to use polyethylene naphthalate layers in place of polyethylene terephthalate layers (For example, see column 1, line 7 to column 2, line 5, column 7, line 26 to column 9, line 3 and column 10, line 60 to column 11, line 4 of Utsumi ('953) and column 3, line 1 to column 5, line 19 of Utsumi ('772)) for the purpose of improving the heat resistance, the heat shrinkage ratio, the mechanical properties and the degree of polarization for polarizing plate which would obviously convey to one of ordinary skill in the art of that the individual layer(s) of polyethylene terephthalate material employed in the optical interference coating of Rogers ('729) can be similarly substituted with polyethylene naphthalate in order to achieved the above mentioned advantages.

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed

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invention must be expressly suggested in anyone or all of the references, rather, the test is what the combined teaching of the references, as a whole, would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 U.S.P.Q. 871 (CCPA 1981).

Moreover, one cannot show nonobviousness by attacking the references individually, where the rejection is based on a combination of references. See In re Merck & Co., 800 F. 2d 1091, 231 U.S.P.Q. 375 (FED. CIR. 1986) and In re Keller, 642 F. 2d 413, 208 U.S.P.Q. 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning the examiner states that it must be recognized that any judgement on obviousness is in a sense necessary a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of one of ordinary skill in the art at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 30, 30(32), 30(33), 30(34) and 30(35) are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers ('729) in view of Utsumi ('953) or Utsumi ('772).

Rogers discloses a multilayer interference film comprising alternating layers of at least first and second diverse polymeric materials [ {(10),(12)} or {(30),(32)} ], wherein the alternating layers includes a refractive index mismatch in at least one plane perpendicular to the film and layer thicknesses suitable to reflect light over a range of wavelengths, note figures 1 and 2 and the associated description thereof, except for explicitly stating that one of the first and second diverse polymeric material comprises polyethylene naphthalate.

Utsumi ('953) and Utsumi ('772) each teach it is known to use polyethylene naphthalate layers in place of polyethylene terephthalate layers in same field of endeavor for the purpose of improving the heat resistance, the heat shrinkage ratio, the mechanical properties and the degree of polarization.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to replace the polyethylene terephthalate layers of Rogers with polyethylene naphthalate layers, as taught by Utsumi ('953) or Utsumi ('772), in order to improve the heat resistance, the heat shrinkage ratio, the mechanical properties and the degree of polarization of the multilayer interference film. Note *In re Leskin*, 125 USPQ 416.

As to the limitations of claim 30(35), it is well known to use polymeric skin layers of a polycarbonate and/or polymethyl methacrylate materials in the same field of endeavor for the purpose of avoiding instabilities and/or to provide for mechanical strength.

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Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the substrate of multilayer interference film of Rogers ('729) in view of Utsumi ('953) or Utsumi ('772) to include at least one polymeric skin layer of a polycarbonate and/or polymethyl methacrylate material (serving as applicant's third polymeric material different from the first and second diverse polymeric materials), as is commonly used and/or employed in the optical art in order to protect or improve the mechanical strength of the multilayer interference film.

4. The disclosure is objected to because of the following informalities:

Newly added Figures 2A, 2B, 3A and 3B, which have been approved by the examiner, each lack a reference to and brief description of the drawing(s). See 37 CFR 1.74.

Appropriate correction is required.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

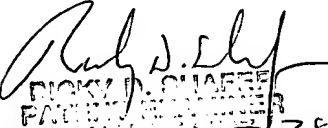
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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

RDS

November 14, 2003

  
RICKY D. SHAFER  
PATENT EXAMINER  
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